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09/815,858**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed March 16, 2003. Favorable action is requested.

§112 Rejections

The Office Action rejects Claims 27-29 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention because, states the Office Action, "[t]he specification does not provide an enabling disclosure how a single logic, as claimed, and the single computer-processable medium, as claimed, can accomplished [sic] all these functions which the specification states that these functions are done by is [sic] multiple logics [sic] encoded on multiple computer-processable mediums." (See page 5, 2nd paragraph, Office Action). Applicants respectfully disagree, and submit that the Examiner misread Claims 27-29 and that the specification of the present application indeed provides enabling disclosure for the use of single or multiple computer-processable media for encoding logic.

The issue raised by the Office Action concerning whether the specification enables one skilled in the art to encode "a single logic" that performs the operation recited in Claim 27 is irrelevant in view of what is actually recited by Claim 27. Contrary to the Examiner's assertion, Claim 27 does not recite "a single logic" or "a single computer-processable medium." Rather, Claim 27 recites "logic" encoded on "at least one computer-processable medium." Accepted rules of grammar suggest that the term "logic" has no singular or plural, much like the terms "water" and "air." Thus, it is not necessary and would be nonsensical to decide whether the specification enables one skilled in the art to encode the operation recited by Claim 27 as "a single logic" or "multiple logics." Such an issue would be analogous to a hypothetical issue of whether one skilled in the art is able to drink "a single water" or "multiple waters," or breath "a single air" or "multiple airs." Thus, the issue raised in the Office Action concerning "a single logic" and "multiple logics" is insufficient to support a § 112 rejection.

The Examiner may be reading the term "logic" as "a computer program." However, the term "a computer program" is not explicitly recited as a limitation of Claim 27. Even if "logic" were read as "a computer program," which may or may not be justified, Applicants submit that one skilled in the art would certainly know how to encode multiple computer

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programs on one computer-processable medium. For example, one hard-disk having a sufficient memory space may be used to store both Microsoft XP and Microsoft Word. If the Examiner challenges this assertion, should it become necessary, Applicants stand ready to provide factual support for this assertion.

Further, it is incorrect to state that the specification of the present Application limits the scope of Claim 27 to encoding logic on multiple computer-processable media. On page 20, lines 9-11, the present Application states that "[i]n another embodiment, the functions of one or more of these components [for example, WARP 210, gateway 216, gatekeeper 228, and subscriber location register 230] may be incorporated into logic encoded on at least one computer-processable medium." [emphasis added]. Applicants submit that the phrase "at least one computer-processable medium" includes using one computer-processable medium, and thus the Examiner's characterization of the specification of the present invention is incorrect.

In fact, the present Application provides an enabling disclosure for one skilled in the art to encode logic on at least one computer-processable medium to perform the operation recited by Claim 27. Some embodiments of the operation of the above-identified components, such as WARP 210, gateway 216, gatekeeper 228, and subscriber location register 230, are described as flow charts, such as the ones in FIGURES 3-5B. Such flow charts are sufficient to satisfy the enablement requirement in cases concerning software instructions, such as logic, because such a flow chart provides the functional acts and the relationship between those acts that allow one skilled in the art to implement the acts using software, hardware, or other suitable device. M.P.E.P. 2106(V)(B)(2) ("Employment of block diagrams and descriptions of their functions is not fatal under 35 U.S.C. 112, first paragraph, providing the represented structure is conventional and can be determined without undue experimentation" citing *In re Donohue*, 193 USPQ 136.) Indeed, the specification also discloses how each component cooperates with other components. See, for example, pages 8-20 of the present Application. Thus, Applicants submit that with the provided description of the operation of each component and the cooperation of all the components, one skilled in the art would be able to encode "logic" of Claim 27 that is operable to perform the operation recited by Claim 27 on "one" computer-processable medium, which is within the scope of "at least one computer-processable medium" of Claim 27. Reconsideration and favorable action are requested.

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Claims 28 and 29 are allowable for reasons analogous to those provided in conjunction with Claim 27. Reconsideration and favorable action are requested.

§103 Rejections

The Office Action rejects Claims 1-33 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,825,883 to Archibald, et al ("*Archibald*") in view of U.S. Pat. No. 6,571,108 to Otsuka, et al. ("*Otsuka*"). Applicants respectfully traverse these rejections for reasons stated below.

Claim 31 is allowable because none of the cited references teaches or suggests "receiving a non-address identifier for a recipient of a user notification message, the non-address identifier being non-unique in the private network," [emphasis added] as recited by Claim 31. In a previous Response to Office Action dated February 16, 2004, Applicants presented an argument that Claim 31 is allowable because "an ID unique in the network of the radio terminal . . ." [emphasis added] described in *Otsuka* (which the previous Office Action appeared to have identified as showing this limitation) is in fact opposite from the "non-unique" identifier of Claim 31 and thus does not show this missing limitation. In response to this previously-presented argument, the present Office Action states in the "Response to Arguments" section that "[a]ll identifications are inherently 'unique', if it did not, then it can not identify anything," thus implying that the limitation of "non-unique" cannot exist with respect to any identifier. Applicants respectfully disagree. For example, page 30, lines 13-18 of the present Application states the following: "As illustrated [in FIGURE 8], the group list of Client Relations may be set up with a user identifier 804 of Mark, which is the same user identifier 804 provided by Joe Banks. However, the Mark included in the Client Relations list is a different user from the Mark included in the Joe list. Thus, each user identifier 804 corresponding to a same list identifier 802 is unique, but identical user identifiers 804 may exist when they correspond to different list identifiers 802." Simply put, in one embodiment, the identifier of "Mark" is non-unique because the name "Mark" by itself does not identify a unique person; it identifies more than one person having the same name "Mark" (e.g. Mark Smith and Mark Jones). Nevertheless, "Mark" is an identifier because "Mark" identifies only the people having the name "Mark" and no others (e.g. Mark Smith and Mark Jones, but not John Smith or John Jones). Thus, the statement in the Office Action regarding the inherent uniqueness of all identifications is incorrect, and other than this incorrect statement, the Office Action has presented no other

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arguments or factual evidence to support the continued rejection of Claim 31. If the Examiner continues to maintain this rejection of Claim 31, Applicants respectfully request the Examiner to provide documentary evidence in support of this rejection. If the Examiner is relying on personal knowledge to support this finding, then Applicants respectfully request the Examiner to provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See M.P.E.P. § 2144.03(C). Without more, Claim 31 is allowable. Reconsideration and favorable action are requested.

As depending from allowable independent Claim 31, dependent Claims 32 and 33 are also allowable. Claim 32 is allowable also because none of the cited references teaches or suggests "providing the sender of the message with non-address identifiers as choices for selection, the non-address identifiers associated with the sender . . ." as recited by Claim 32. Claim 33 is allowable because none of the cited references teaches or suggests "determining a plurality of address identifiers based on the sender of the message and the non-address identifier; and addressing the message with the address identifiers for multiple deliveries to the recipient in the private network." Applicants argued this in the last Response, but the present Office Action does not challenge Applicants' previously presented argument that these limitations are not shown by the cited references. Reconsideration and favorable action are requested.

Claim 18 is allowable over a combination of *Archibald* and *Otsuka* because the combination does not teach or suggest "assigning a user identifier to a first mobile station identifier corresponding to a first mobile station in a private network . . .," as recited by Claim 18. The Office Action appears to argue that "a user ID 92" in FIGURE 2 of *Archibald* shows "a user identifier" of Claim 18 and ". . . an ID unique in the network of the radio terminal" described in the identified portion of *Otsuka* shows "a first mobile station identifier" of Claim 18. Applicants disagree. But even if these assertions are correct, which they are not, the cited references do not teach or suggest "assigning a user identifier to a first mobile station identifier corresponding to a first mobile station . . ." [emphasis added]. Further, the Office Action still does not even assert that the proposed combination teaches or suggests assigning the ID of Archibald to the ID of Otsuka. In one embodiment, assigning a user identifier to a first mobile identifier allows ". . . messages . . . [to be] sent to a mobile station based on an identifier for the user of the mobile station rather than based on an identifier for the mobile station itself, such that a sender need not have knowledge of the identifier for the mobile station." (See page 2, lines 4-7 of the

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present application). Because the proposed combination of the cited references does not show the missing limitation and nothing in the Office Action asserts that the combination shows the missing limitation, Claim 18 is allowable.

Further, the Office Action has not shown a motivation to combine the references. In response to Applicants' previously-presented arguments concerning the lack of motivation to combine the cited references, the Office Action relies on an alleged purpose of "... specifically identifying the mobile station in the current and other private networks" as constituting a motivation for one skilled in the art to combine *Archibald* and *Otsuka*. Even if the purpose of combination stated in the Office Action were sufficient to show motivation, which it does not, the stated purpose is not found anywhere in any of the cited references. For example, the stated object of the invention of *Otsuka* is "to provide a private branch mobile communication system and . . . method wherein, even where a local area switched network is formed from a plurality of PBXs and the individual PBXs manage attribute information of radio terminals independently of each other, a radio terminal used in a home PBX can perform, also in a radio area managed by a different PBX, continuation of communication or origination or termination of a call freely without performing roaming processing." (see column 3, lines 21-30). The invention of *Archibald* provides a method/apparatus that is used to account for software usage based on the amount of use. (see column 3, lines 37-56). It cannot be stated that these goals described in the cited references suggest the purpose of the proposed combination stated by the Examiner (namely, the identification of a mobile station in a network). And no evidence has been cited in the Office Action showing that the stated purpose for supporting a motivation to combine is in the knowledge of those skilled in the art. Rather, the Office Action provides a speculation by the PTO, which is as a matter of law insufficient. See *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention) [emphasis added].

Between the cited references and the present Application, the present Application is the only document that discloses, in some embodiments, an identification of a mobile station in a private network. However, the PTO is prohibited from using the disclosure of the present Application to provide a motivation to combine the cited references because the M.P.E.P specifically prohibits the PTO from basing a rejection on hindsight. See M.P.E.P.

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§2141.01(III). If the Examiner is relying on personal knowledge to support this rejection (since the Examiner has not attempted to identify any portion of the cited references to support his allegation), then Applicants respectfully request the Examiner to provide an affidavit or a declaration setting forth specific factual statements and explanation to support the finding, as stated in M.P.E.P. §2144.04 (C) and 37 C.F.R. 1.104(d)(2).

As depending from allowable independent Claim 18, dependent Claims 19-26 are also allowable. Reconsideration and favorable action are requested.

Claim 1, 12, 27, 28, 29, and 30 are allowable for reasons analogous to those provided in conjunction with Claim 18. Reconsideration and favorable action are requested.

As depending from their respective allowable independent Claims 1, 12, and 18, dependent Claims 2-11, 13-17, and 19-26 are also allowable. Reconsideration and favorable action are requested.

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For the foregoing reasons and for reasons clearly apparent, Applicants respectfully request allowance of all pending claims.

If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 19-2179 of Siemens Information & Communications Products, L.L.C.

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Respectfully requested,

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